

REMARKS

Claims 1–20 and 25–33 are pending in the present application. Claims 21–24 were canceled as directed to a non-elected species.

Claims 4 and 14 were amended solely to correct typographical and grammatical errors within those claims.

Reconsideration of the claims is respectfully requested.

35 U.S.C. § 102 (Anticipation)

Claims 1, 5–8, 14–17, 19, 25, 28–30 and 32 were rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 5,933,569 to *Sawabe et al.* This rejection is respectfully traversed.

A prior art reference anticipates the claimed invention under 35 U.S.C. § 102 only if every element of a claimed invention is identically shown in that single reference, arranged as they are in the claims. MPEP § 2131; *In re Bond*, 910 F.2d 831, 832, 15 U.S.P.Q.2d 1566, 1567 (Fed. Cir. 1990). Anticipation is only shown where each and every limitation of the claimed invention is found in a single prior art reference. MPEP § 2131; *In re Donohue*, 766 F.2d 531, 534, 226 U.S.P.Q. 619, 621 (Fed. Cir. 1985).

The cited portion of *Sawabe et al.*, Figure 16 and the accompanying description, is substantially similar to a portion of the disclosure of a typical digital video disk system in Figure 1 of the present application, and may be utilized for direct display of DVD data. However, the

design depicted in *Sawabe et al* does not enable file selection and “navigation” of the content on a DVD by the user. Thus, Figure 1 of the application includes a navigation manager 38 that receives user commands to select the track (or “chapter” or file) on the DVD to be played, with presentation engine 82 responsively generating the appropriate video, audio, VBI and sub-picture decoder control and synchronization system. In addition, the present invention includes a file reader 310 and a navigator 318, depicted in Figure 9 of the application and recited in each of independent claims 1, 20 and 25, which operate in conjunction to allow the user to select content on the DVD for playback. Such a feature is not shown or suggested by *Sawabe et al*, which merely depicts a system controller 100 receiving undefined input from input unit 98, presumably including play, fast forward, reverse, and pause functions. *Sawabe et al* contains no teaching or suggestion of components enabling a user to select a particular encoded data stream (e.g., track, “chapter,” or file) on a DVD for playback.

Therefore, the rejection of claims 1, 5–8, 14–17, 19, 25, 28–30 and 32 under 35 U.S.C. § 102 has been overcome.

35 U.S.C. § 103 (Obviousness)

Claims 2–4, 20 and 26–27 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sawabe et al* in view of U.S. Patent No. 5,999,698 to *Nakai et al*. Claims 9–11 and 31 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sawabe et al* in view of U.S. Patent No. 5,987,417 to *Heo et al*. Claims 12–13 were rejected under 35 U.S.C. § 103(a) as being

unpatentable over *Sawabe et al* in view of *Heo et al* and U.S. Patent No. 5,990,958 to *Bheda et al*. Claims 18 and 33 were rejected under 35 U.S.C. § 103(a) as being unpatentable over *Sawabe et al* in view of U.S. Patent No. 5,642,171 to *Baumgartner et al*. These rejections are respectfully traversed.

In *ex parte* examination of patent applications, the Patent Office bears the burden of establishing a *prima facie* case of obviousness. MPEP § 2142; *In re Fritch*, 972 F.2d 1260, 1262, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992). The initial burden of establishing a *prima facie* basis to deny patentability to a claimed invention is always upon the Patent Office. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Piasecki*, 745 F.2d 1468, 1472, 223 U.S.P.Q. 785, 788 (Fed. Cir. 1984). Only when a *prima facie* case of obviousness is established does the burden shift to the applicant to produce evidence of nonobviousness. MPEP § 2142; *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). If the Patent Office does not produce a *prima facie* case of unpatentability, then without more the applicant is entitled to grant of a patent. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); *In re Grabiak*, 769 F.2d 729, 733, 226 U.S.P.Q. 870, 873 (Fed. Cir. 1985).

A *prima facie* case of obviousness is established when the teachings of the prior art itself suggest the claimed subject matter to a person of ordinary skill in the art. *In re Bell*, 991 F.2d

781, 783, 26 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1993). To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed invention and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. MPEP § 2142.

As noted above, each of the independent claims recites a file reader and a navigator, which are not shown or suggested by *Sawabe et al.* Such features are also not shown or suggested in any of *Nakai et al.*, *Heo et al.*, *Bheda et al.* or *Baumgartner et al.*

Therefore, the rejection of claims 2–4, 9–13, 18, 20, 26–27, 31 and 33 under 35 U.S.C. § 103 has been overcome.

AMENDMENTS WITH MARKING TO SHOW CHANGES MADE

The title of the invention was amended herein as follows:

SYSTEM AND APPARATUS FOR DIGITAL AUDIO/VIDEO DECODER
SPLITTING SIGNAL INTO COMPONENT DATA STREAMS FOR RENDERING
AT LEAST TWO VIDEO SIGNALS

Claims 4 and 14 were amended herein as follows:

- 1 4. (amended) The digital audio/video decoder as recited in claim 3, wherein the [one or] more
2 than one predefined functions comprise[s]:
3 a play function;
4 a pause function;
5 a menu function;
6 a stop function;
7 a previous function; and
8 a next function.
9

1 14. (amended) The digital audio/video decoder as recited in claim 1, wherein the three or more
2 renderable signals comprise[s]:
3 a renderable audio signal;
4 a renderable video signal; and
5 a renderable subpicture signal.


If any issues arise, or if the Examiner has any suggestions for expediting allowance of this Application, the Applicant respectfully invites the Examiner to contact the undersigned at the telephone number indicated below or at *dvenglarik@davismunck.com*.

The Commissioner is hereby authorized to charge any additional fees connected with this communication or credit any overpayment to Deposit Account No. 50-0208.

Respectfully submitted,

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